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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,074	12/01/2003	Charles N. Godin	067437-5009-US01	2730

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EXAMINER	
GORDON, BRIAN R	
ART UNIT	PAPER NUMBER
1797	
MAIL DATE	DELIVERY MODE
01/26/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/725,074	GODIN ET AL.	
	Examiner	Art Unit	
	Brian R. Gordon	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 14-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, 14-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 6, 2009 has been entered.

Response to Arguments

2. Applicant's arguments filed November 8, 2007 have been fully considered but they are not persuasive.

In view of applicant's arguments, the there previous 112, new matter rejection is hereby withdrawn.

It should be noted that applicant's remarks states claims 1-10 and 13-16 are pending. However claim 13 has been canceled.

As to applicant's arguments that the heat sealing as taught by Bennett is not a fluid seal. It should be noted that such argument is not commensurate in scope with that of claim 1. The claim makes no mention of "fluid seal". However, it would be inherent from the nature of the invention of Bennett, that the heat seal would also be a fluid seal. If not, the device would not function properly as intended by Bennett.

As to applicant argument that the present invention uses a discrete substance such as silicone oil, oil, or grease, it should be noted none of substances are claimed. It is noted that the features upon which applicant relies (i.e., silicone oil, oil, and grease) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

It should be noted that the claim states that "the static seal.....is formed in part with a sealing agent". Since the claim does not limit the sealing agent, the examiner interprets the claim to mean that any agent that used in the formation of the seal as implied by the claim. Therefore, heat sealing incorporates use of sealing agent, heat that is used to form the seal. The seal is formed with use of the sealing agent, heat.

Furthermore it should be noted that as indicated in the prior Office Action, Bennett discloses the securing/sealing method is not limited to heat sealing. Bennett discloses “an elastic membrane 68' could then be secured **by any suitable means** such as heat sealing..” Therefore, the use of other well-known suitable means such as glue (including heat activated glues) and other adhesives and bonding agents would also be covered therein.

In view of the remarks herein, the examiner hereby maintains the previous rejection.

Claim Interpretation

3. Claims 3-4 are not further structurally limiting of the claimed system. The claims are directed to how the device is intended to be used or arranged with respect to the fluid receptacles that are not elements of the pipetting system. As to claim 3, is it

applicant's intent to further limit the device to include a controller, computer, or other electronic device that allows for automated movement/aligning of the device?

Claim 4 does not add any further structure to that of claim 1. Claim 4 is directed to how one intends for the device to be employed with unclaimed elements (i.e. fluid receptacles and mulitwell plate).

It should be noted that claim 1 recites one **or** more removable pipette tips. The more pipette tips are optional and not required. As such any dependent claims directed to "the removable pipette tip arrays"; "the pipette tip arrays"; or any other variation thereof are considered limiting only when more than on removable pipette tip is present. The examiner suggests applicant amend the claims to be consistent with the "one or more" language of claim 1.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 3-10 and14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al. US 4, 444,062.

Bennett et al. discloses liquid transfer device having a plunger mounted for sliding movement within a hand-held housing, a plurality of rods projecting from said plunger, a barrel section having a plurality of through-passages formed therein equal in number to the number of said rods, means for detachably connecting said barrel means to said housing and elastic diaphragm means adapted to be secured intermediate said housing and barrel means whereby said rods will press said diaphragm into said passages when said barrel means is connected to said housing. The diaphragm can be connected either to the housing over the ends of said rods or may be connected to the barrel means over the passages and the entire barrel means may be formed of plastic material for disposal after a single use. In the disposable form the diaphragm may be of relatively thin material since it does not have to be heavy enough to withstand repeated uses (column 2, line 34).

An elastic rubber membrane 24 of latex completely overlies the recess 16 and the ends of the rods protruding therefrom and the periphery of the membrane is secured in the groove 22 by means of an endless O-ring 26 having dimensions suitable for press fitting the O-ring into the groove 22.

As seen in Figure 1 the membrane is secured to the upper frame and sandwiched between the two respective sections of the frame.

A shallow groove is formed in the upper surface of the barrel member 52 (frame) which completely surrounds the row of wells 60 (open central regions). A thin plastic diaphragm 68 (membrane) of any suitable plastic material having a limited degree of elasticity is stretched over the top of the wells 60 and secured in the groove 67 by

means of an elastic O-ring 69 pressed into the groove 67 (clamping assembly). The groove 67 is in alignment with the grooves 22 in the housing 12 when the barrel member 52 is secured to the housing 12.

An elastic membrane 68' could be secured to the upper surface of the barrel member 52' by any suitable means such as heat sealing (sealing agent) (column 5, lines 21-22).

Threaded apertures 56 and screws 54 help align and claim the portions of the frame together.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. In the alternative, claims 1, 3-10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. As stated in the "Response to arguments, the claim is not limited to any sealing agent. However, Bennett discloses any suitable securing/sealing means may be employed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ a conventionally known sealing agent such as glue or any other bonding agent within the device of Bennett.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. as applied to claims 1, 3-10 and 14-16 above, and further in view of Powers, Ingenhoven et al., or Shumate et al.

Bennett et al. does not disclose the device as being automated.

While a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art, Powers, Ingenhoven et al., or Shumate et al. disclose automated pipette devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to automate the operation the device of Bennett et al. for automated pipettes are conventionally known in the art to ensure accurate handling of liquid and streamlining various methods as well.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McNeil discloses various methods and agents for sealing membranes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/
Primary Examiner
Art Unit 1797